



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/708,475

11/09/2000

Joseph T. Strupczewski

2489.0028-12

7075

22852

7590

08/30/2002

FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 08/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/708,475

Applicant(s)

STRUPCZEWSKI et al.

Examiner

Brenda Coleman

Art Unit

1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 19, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48, 50-56, and 58-115 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26, 28, 96-103, and 109-115 is/are allowed.
- 6) ☒ Claim(s) 1-13, 25, 27, 29-48, 50-56, 58-95, and 104-108 is/are rejected.
- 7) ☒ Claim(s) 14-24 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 1624

DETAILED ACTION

Claims 1-48, 50-56 and 58-115 are pending in the application.

This action is in response to applicant's amendment filed June 19, 2002. Claims 1, 9, 25-33, 46, 54, 66, 74, 86-89, 92, 93, 96 and 104 have been amended and claims 49 and 57 have been canceled.

Response to Amendment

Applicant's arguments filed June 19, 2002 have been fully considered with the following effect:

1. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.
2. The applicants' amendment and arguments are sufficient to overcome the 35 U.S.C. § 112, first paragraph rejection of the last office action which is hereby **withdrawn**.
3. The applicants' amendment and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections of the last office action which are hereby **withdrawn**.
4. The applicants' amendment and arguments are sufficient to overcome the 35 U.S.C. § 102, anticipation rejection of the last office action which is hereby **withdrawn**.

Art Unit: 1624

5. With regards to the 35 U.S.C. § 103, obviousness rejection of claims 1-6, 10-13, 30, 35, 44 and 45, the applicants' arguments have been fully considered but are not found persuasive. The applicants' stated that the claimed invention specifically excludes the compounds of Stokbroekx by reciting the following proviso in independent claims 1 and 30: "with the exclusion of compounds wherein X is O or S, Y is hydrogen, and R is hydrogen, C₁₋₄ alkyl, chlorine, fluorine, bromine, iodine, cyano, C₁₋₄ alkoxy, *aryl*, or -COOR₂₃ where R₂₃ is C₁₋₄ alkyl". The proviso at the end of claims 1 and 30 is actually with the exclusion of compounds wherein X is O or S, Y is hydrogen, and R is hydrogen, C₁₋₄ alkyl, chlorine, fluorine, bromine, iodine, cyano, C₁₋₄ alkoxy, or -COOR₂₃ where R₂₃ is C₁₋₄ alkyl, however, this does not exclude the compounds where R is carboxyl. The definition of R³ in EP 0 398 425 includes -COOR⁴ where R⁴ is hydrogen.

Claims 1-6, 10-13, 30, 35, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stokbroekx et al., EP 0 398 425. For reasons of record and stated above.

6. The applicants' amendment and arguments are sufficient to overcome the 35 U.S.C. § 103, obviousness rejection of claims 1-4, 6, 9-13, 25, 27, 30, 33-35, 38-39 and 42-45 over Smith et al., U.S. Patent No. 4,590,196, in the last office action which is hereby **withdrawn**.

In view of the amendment dated June 19, 2002, the following new grounds of rejection apply:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1624

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-13, 25, 27, 29-48, 50-56, 58-95 and 104-108 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claims 1 (and claims dependent thereon) are missing the double bonds in the phenyl ring which appears in claim 1 of U.S. 5,658,911. Instead of the circle which appears in the amendment.

§ 1.121 Manner of making amendments.

(a) Erasures, additions, insertions, or alterations of the Office file of papers and records must not be physically entered by the applicant. Amendments to the application (excluding the claims) are made by filing a paper (which should conform to § 1.52) directing or requesting that specified amendments be made. The exact word or words to be stricken out or inserted by said amendment must be specified and the precise point indicated where the deletion or insertion is to be made.

(b) Except as otherwise provided herein, a particular claim may be amended only by directions to cancel or by rewriting such claim with underlining below the word or words added and brackets around the word or words deleted. The rewriting of a claim in this form will be construed as directing the cancellation of the original claim; however, the original claim number followed by the parenthetical word "amended" must be used for the rewritten claim. If a previously rewritten claim is rewritten, underlining and bracketing will be applied in reference to the previously rewritten claim with the parenthetical expression "twice amended," "three times amended," etc., following the original claim number.

(c) A particular claim may be amended in the manner indicated for the application in paragraph (a) of this section to the extent of corrections in spelling, punctuation, and typographical errors. Additional amendments in this manner will be admitted provided the changes are limited to (1) deletions and/or (2) the addition of no more than five words in any one claim. Any amendment submitted with instructions to amend particular claims but failing to conform to the provisions of paragraphs (b) and (c) of this section may be considered nonresponsive and treated accordingly.

(d) Where underlining or brackets are intended to appear in the printed patent or are properly part of the claimed material and not intended as symbolic of changes in the particular claim, amendment by rewriting in accordance with paragraph (b) of this section shall be prohibited.

(e) In reissue applications, both the descriptive portion and the claims are to be amended by either (1) submitting a copy of a portion of the description or an entire claim with all matter to be

Art Unit: 1624

deleted from the patent being placed between brackets and all matter to be added to the patent being underlined, or (2) indicating the **exact word** or words to be stricken out or inserted and the precise point where the deletion or insertion is to be made. Any word or words to be inserted must be underlined. See § 1.173.

(f) Proposed amendments presented in patents involved in reexamination proceedings must be presented in the form of a full copy of the text of: (1) Each claim which is amended and (2) each paragraph of the description which is amended. Matter deleted from the patent shall be placed between brackets and matter added shall be underlined. Copies of the printed claims from the patent may be used with any additions being indicated by carets and deleted material being placed between brackets. Claims must not be renumbered and the numbering of the claims added for reexamination must follow the number of the highest numbered patent claim. No amendment may enlarge the scope of the claims of the patent. No new matter may be introduced into the patent.

- b) Claims 9 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of X which includes a moiety which does not indicate a second point of attachment, i.e. S-, which appears in claim 1 of U.S. 5,658,911.
- c) Claims 9 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of Y which is not written in the form of a Markush group, "or" between the last two moieties is suggested.
- d) Claims 9 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the period after the F in the definition of Y.
- e) Claims 9 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the moiety CL in the definition of R.
- f) Claims 9 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of R which is not written in the form of a Markush group, "or" between the last two moieties is suggested.

Art Unit: 1624

- g) Claims 25 (and claims dependent thereon) include the insertion of or indicated by the underlining of “or”, which appears in claim 25 of U.S. 5,658,911.
- h) Claims 25 (and claims dependent thereon) include the moiety phenylsulfonyl (one word) in the definition of R_2 which does not appear in claim 25 of U.S. 5,658,911.
- i) Claims 25 (and claims dependent thereon) are missing the double bonds in the phenyl ring which appears in claim 25 of U.S. 5,658,911. Instead of the circle which appears in the amendment.
- j) Claims 27 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of R in the proviso which is not written in the form of a Markush group, “or” between the last two moieties is suggested.
- k) Claims 29 (and claims dependent thereon) are missing the double bonds in the phenyl ring which appears in claim 29 of U.S. 5,658,911. Instead of the circle which appears in the amendment.
- l) Claims 30 (and claims dependent thereon) is missing the capital letter in the definition of R_{22} , i.e. iS which appears in claim 30 of U.S. 5,658,911.
- m) Claims 30 (and claims dependent thereon) contains “is” in the definition of p on page 12, third line from the bottom of the page which does not appear in claim 30 of U.S. 5,658,911.

Art Unit: 1624

- n) Claims 30 (and claims dependent thereon) are missing the double bonds in the phenyl ring which appears in claim 30 of U.S. 5,658,911. Instead of the circle which appears in the amendment.
- o) Claims 31 (and claims dependent thereon) are missing the double bonds in the phenyl ring which appears in claim 31 of U.S. 5,658,911. Instead of the circle which appears in the amendment.
- p) Claims 32 (and claims dependent thereon) includes a comma after the amino in the definition of Y which does not appear in claim 32 of U.S. 5,658,911.
- q) Claims 32 (and claims dependent thereon) includes the moiety R_{21} in the definition of R_{22} , on page 19, line 6 second occurrence, which does not appear in claim 32 of U.S. 5,658,911.
- r) Claims 32 (and claims dependent thereon) are missing the double bonds in the phenyl ring which appears in claim 32 of U.S. 5,658,911. Instead of the circle which appears in the amendment.
- s) Claims 33 (and claims dependent thereon) are missing the double bonds in the phenyl ring which appears in claim 33 of U.S. 5,658,911. Instead of the circle which appears in the amendment.
- t) Claim 37 is vague and indefinite in that it is not known what is meant by the dependency on claim 29 which occurs twice.

Art Unit: 1624

- u) Claims 46 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of R_5 which is not written in the form of a Markush group, “or” between the last two moieties is suggested.
- v) Claims 54 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of Y and R which are not written in the form of a Markush group, “or” between the last two moieties of each is suggested.
- w) Claims 66 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of R_5 which is not written in the form of a Markush group, “or” between the last two moieties is suggested.
- x) Claims 74 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of Y and R which are not written in the form of a Markush group, “or” between the last two moieties of each is suggested.
- y) Claims 86 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of R_5 which is not written in the form of a Markush group, “or” between the last two moieties is suggested.
- z) Claims 87 (and claims dependent thereon) are vague and indefinite in that there is not second point of attachment for the moiety $-N(R_2)$ in the definition of X.
- aa) Claims 87 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of R_5 which is not written in the form of a Markush group, “or” between the last two moieties is suggested.

Art Unit: 1624

- bb) Claims 88 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of R_5 which is not written in the form of a Markush group, “or” between the last two moieties is suggested.
- cc) Claims 89 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of R_5 which is not written in the form of a Markush group, “or” between the last two moieties is suggested.
- dd) Claims 92 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of R_5 which is not written in the form of a Markush group, “or” between the last two moieties is suggested.
- ee) Claims 93 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of R_5 which is not written in the form of a Markush group, “or” between the last two moieties is suggested.
- ff) Claims 104 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of Y and R which are not written in the form of a Markush group, “or” between the last two moieties of each is suggested.

Claim Objections

- 8. Claims 14-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 1624

Allowable Subject Matter

9. Claims 26, 28, 96-103 and 109-115 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays and Tuesdays from 9:00 AM to 3:00 PM and from 5:30 PM to 7:30 PM and on Wednesday thru Friday from 9:00 AM to 6:00 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Brenda Coleman
Primary Examiner AU 1624
August 29, 2002